IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Mark J. Kraffert	§	Group Art Unit: 2857
		§	
Serial No.:	09/776,364	§	
		§	Examiner: Jeffrey R. West
Filed:	February 2, 2001	§	
		§	
For:	Sharing Data Files in a Test Environment	§	Atty. Dkt. No.: MCT.0134US (MUEI-0558.00/US)

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SUR-REPLY BRIEF RESPONSIVE TO EXAMINER'S RESPONSE TO REPLY BRIEF

Sir:

A. Lack of Motivation to Combine Slutz and Fujimori

In the Examiner's Response to Reply Brief (hereinafter "Examiner's Response"), the Examiner maintained that the Examiner has provided the motivation to combine Slutz and Fujimori in the Examiner's Answer. Examiner's Response at 2-3. The Examiner again pointed to the various teachings of Fujimori that the Examiner contended provides the requisite suggestion to combine Slutz and Fujimori.

However, as explained previously by Appellant, the teachings of Fujimori have nothing to do with performing tests, which is the subject matter of Slutz. The passages of Fujimori quoted by the Examiner in the Examiner's Response describe the issue of overwriting waveform data in a file (where the waveform data is waveform that represents the sounds of musical

instruments). Fujimori, 1:26-2:10. As noted by the Examiner, the stated goal of Fujimori is "automatically creating a character string representing the property of the musical tone information such as the sampling waveform data." Fujimori, 2:21-25. These cited passages of Fujimori would not have suggested a modification of Slutz in the manner proposed by the Examiner.

The configuration file of Slutz is used for performing the test procedures in Slutz – the technique of assigning a file name using a character string that represents the property of musical tone information as taught by Fujimori clearly would not have suggested that this same technique be used for creating a file name for the configuration file of Slutz. The only basis for the combination of the teachings of Slutz and Fujimori is the disclosure of Appellant's invention, which clearly constitutes impermissible hindsight. *See In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.Q.P.2d 1443 (Fed. Cir. 1992) (holding that the combination of teachings from a reference relating to fastening a hose clamp cannot properly be combined with a reference relating to fasteners for garments since no reason, suggestion, or motivation could be found in the prior art "whereby a person of ordinary skill in the field of the invention would make the combination.").

Therefore, the obviousness rejection of the claims over Slutz and Fujimori is clearly defective.

B.   Mis-Application of Slutz to Claim 1

As noted in Appellant's Appeal Brief and the Reply Brief, the Examiner has mis-applied Slutz to the following element of claim 1: the first and second test systems using *the first* data file in performing respective first and second tests. The teachings of Slutz require that different configuration files have to be used to perform different tests. In response to Appellant's

arguments in this regard, the Examiner cited column 2, lines 52-59, of Slutz as disclosing first and second test systems using the same data file in performing respective first and second tests.

Appellant respectfully submits that there is no such teaching or suggestion in the cited passage. In fact, in reviewing Slutz as a whole, there simply is no teaching or suggestion in Slutz that multiple test systems will use the same configuration file to perform respective tests. In fact, as noted in the Appeal Brief and Reply Brief, Slutz teaches that "particular features and statement characteristics that produce problems can be emphasized merely by changing a few parameters in the file." Slutz, 8:8-11. This suggests that parameters of the configuration file 400 are changed for different tests, which indicates that different configuration files would be used if the test program of Slutz were executed on multiple PC clients.

The Examiner also stated that the disclosure of Slutz is "comparable to the method disclosed in the instant invention ...." Examiner's Response at 7 (citing page 2, line 30-page 3, line 11, of the present Specification). As noted in the cited passage of the Specification, a common set of data files 24 are shared by different test systems 12, 14. A further statement not quoted by the Examiner is that "the test system 12 can use the data files 24 in a first test, and the test system 14 can use the *same* set of data files in the next test." There is no teaching or suggestion in Slutz that a test program in one PC would use the configuration file for the test run by the first PC, while a second test program in a second PC would read the same configuration file to run the test in the second PC. Therefore, the statement by the Examiner that the disclosure of Slutz is comparable to the method disclosed in the present application is erroneous.

The foregoing is a further reason that the final rejection of claim 1 is defective.

C.   Defective Rejection of Claims of Group 5 Over Slutz, Fujimori and Talley

Appellant argued in the Appeal Brief and Reply Brief that the hypothetical combination of Slutz, Fujimori, and Talley does not disclose or suggest searching a predetermined directory on a device to find a *test* file containing a string that is concatenated from received first and second parameters. Rather, Talley, describes operations that look for a *configuration file* and determines if the configuration file exists in the user's home directory. Talley, 6:18-23. Looking for the configuration file of Talley is not the same as searching a directory to find a *test* file, as recited in the claims.

In the Examiner's Response, the Examiner stated that "although the invention of Talley does not specifically use the word 'test' since the configuration file of Slutz and Fujimori is taken as a test file, the addition of Talley to include searching a predetermined directory on a device to find a configuration file meets a limitation for searching a directory to find a test file." Examiner's Response at 11-12.

Again, this is a classic example of piecemeal application of references to combine unrelated elements to achieve the claimed invention. The rationale provided by the Examiner appears to be that because Talley uses the word "configuration file" (a word also used in Slutz), that this would be sufficient hook to combine Talley with Slutz and Fujimori. Appellant respectfully submits that there clearly did not exist any motivation to combine the teachings of Talley into the asserted teachings of Slutz and Fujimori. As taught by Talley, its configuration file contained entries that describe the characteristics and contents of a particular database. Talley, 4:16-19. There is no suggestion anywhere within Talley that the technique taught by Talley with respect to its configuration file can be applied to the configuration file of Slutz.

Therefore, it is respectfully submitted that the final rejection of the claims of Group 5 is defective.

D. Defective Rejection over Gartner and Fitting

In the Examiner's Response, the Examiner noted that Gartner "discloses implementing the method ... wherein the user supplies a first value, relating to the file name, and a second value, relating to the name of the server/database system under test, (column 5, lines 41-54) ...." Examiner's Response at 13. The cited passage of Gartner describes a relational database system that provides for definition of relations that accommodate existence of an attribute that refers in some way to a file in a file system. As further noted by the Examiner, a user (or users) has to supply the file name and the server/database name to the database system. This is contrasted to the teachings of claim 1, which recites first and second test systems that (1) *receive* plural parameters, (2) identify a file name of a first data file to use in the first and second tests, and (3) use the first data file in performing the respective first and second tests. Multiple users supplying the noted information to the database system of Gartner cannot satisfy the requirement of claim 1 that first and second test systems *receive* plural parameters and perform the remaining tasks of claim 1.

The Examiner stated that Gartner also discloses that this system is "applicable for a plurality of users accessing the system files for multiple tests concurrently ...." Examiner's Response at 13. This teaching of Gartner clearly cannot satisfy the claim, since the applications and users in Gartner clearly do not receive plural parameters, do not identify a file name of a first data file to use in the first and second tests based on the plural parameters, and do not use the first data file in performing respective first and second tests.

The remaining arguments presented by the Examiner regarding Fitting have already been

rebutted in the Appeal Brief, and Appellant does not repeat rebuttal arguments here.

E.   Conclusion

Also, the remaining assertions made in the Examiner's Response have been rebutted in

the Appeal Brief and Reply Brief filed by Appellant.

In view of the foregoing, reversal of all final rejections is respectfully requested.

Respectfully submitted,

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